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IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED AND AVENT AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Whether the Federal Circuit has erred in holding that prosecution disclaimer can be used to read a limitation back into an issued patent claim, after removal of that limitation during prosecution to broaden the claim away from it.

Whether the Federal Circuit has erred in holding that claim construction and patent validity rulings can be entered without reliance on the evidentiary underpinnings required by this Court's precedent.

CORPORATE DISCLOSURE STATEMENT

Petitioner Nouri E. Hakim is a private individual and part owner of Luv n' care Ltd. Luv n' care, Ltd. has no parent corporation and no publicly held company owns 10% or more of its stock.

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OPINIONS BELOW

The opinion of the Court of Appeals is reported at 479 F.3d 1313 and is set forth in the Appendix ("App.") at App. 1a-15a. The order denying the petition for rehearing was reported at 2007 U.S. App. LEXIS 11682 (App. 49a-50a). The judgment of the United States District Court for the Western District of Louisiana regarding the '931 patent is reported at 2005 U.S. Dist. LEXIS 16830 (App. 18a-19a); its judgment regarding the '620 patent is are reported at 2005 U.S. Dist. LEXIS 16831 (App. 16a-17a); and its judgment regarding Hakim's expert declaration are reported at 2005 U.S. Dist. LEXIS 16829 (App. 65a-67a). The Magistrate's Report and Recommendation regarding the '931 patent is reported at 2005 U.S. Dist. LEXIS 16827 (App. 33a-48a); his Report and Recommendation regarding the '620 patent is reported at 2005 U.S. Dist. LEXIS 16833 (App. 20a - 32a); and his Order regarding the Hakim Declaration is reported at 2005 U.S. Dist. LEXIS 16828 (App. 68a-69a).

JURISDICTION

The judgment of the Court of Appeals was entered on February 23, 2007. A petition for rehearing was filed and denied on May 2, 2007. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

The District Court had jurisdiction to hear Petitioner's claim for patent infringement under 28 U.S.C. § 1338(a). The Federal Circuit had jurisdiction to hear Petitioner's appeal under 28 U.S.C. § 1295(a)(1).

CONSTITUTIONAL PROVISION INVOLVED

Article I, section 8, clause 8 of the Constitution provides:

> "Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries."

REGULATORY PROVISIONS

Section § 1.75 of the Code of Federal Regulations provides:

> More than one claim may be presented provided they differ substantially from each other . . . 37 C.F.R. § 1.75(b).

> The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 C.F.R. § 1.75(d)(1).

STATEMENT OF THE CASE

This case raises questions of significant importance to patent claim construction, namely, the factual and legal methodology that must be followed to assess the meanings of claim terms, which affects all issues of patent infringement and validity.

Throughout its history, this Court has repeatedly set forth the evidentiary requirements pertinent to construing patent claim terminology. In *Markman,* this Court acknowledged that the process of claim construction has various evidentiary underpinnings associated with it. *Markman v. Westview Instruments, Inc.,* 517 U.S. 370 (1996). Further thereto, it assigned the judge the role of construing patent terms in a manner that fully comports with the specification and claims and preserves the patent's i ternal coherence. *Markman,* 517 U.S. at 390. Subsequent to *Markman,* however, the Court of Appeals' treatment of the various evidentiary requirements, and its approaches to claim construction, have been widely recognized to have promoted no predictability or uniformity.

Furthermore, as shown here, it can produce entirely illogical and unjust results. In this case, the district court refused to hold a Markman hearing and took no testimony from anyone skilled in the art as part of its construction of the claims. Rather, it chose to enter claim construction and validity rulings without reliance on any evidence regarding the meaning of disputed terms to those of engineering skill in the field of the invention. On appeal, the Federal Circuit affirmed the district court's findings, even though the fundamental evidentiary requirements mandated by this Court's precedent were simply not present. It held that claim construction and fact finding regarding the disputed terms may "not be necessary", though the parties below disputed the terms' construction and the legal issue of anticipation on summary judgment turned on the disputed construction. As a result, the Court of Appeals upheld thoroughly illogical claim construction rulings that "invert" is the same as "lift", and that a hole is not an opening.

Furthermore, the Court set forth a new rule of prosecution disclaimer under which applicants who amend a claim for the purposes of broadening it can still have their claims

limited to the prior, narrower, version of the claim that was abandoned. The court ruled that the narrower limitation continues to control unless the prosecution history is also amended to 'rescind' the prior remarks about it, even if the limitation itself was expressly deleted from the claim.

This is expressly contrary to this Court's precedent that the words of the claims and specification themselves control, and is contrary to the principles applied by the Patent Office during prosecution. Furthermore, since patents are frequently amended during prosecution to broaden their claims – particularly in continuation applications – the decision drastically undermines the value of large numbers of patents issued before pronouncement of this newest precedent.

2. It has been a fundamental patent principle for well over one hundred years that the words in the claims are critical to determining a patent's scope.[1] The evidentiary findings necessary to construe those claims have been set forth by this Court on numerous occasions. For one, the plain meaning of the claim language is highly important. Because the patentee is required to "define precisely what his

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1. *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876) (the claim is "of primary importance, in the effort to ascertain precisely what it is that is patented."); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961) ("the claims made in the patent are the sole measure of the grant"); *White v. Dunbar*, 119 U.S. 47, 52 (1886); *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 419 (1908) ("the claims measure the invention"); *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895) ("if we once begin to include elements not mentioned in the claim, in order to limit such claim . . . we should never know where to stop"). *See also, Phillips v. A.H Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*) ("It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude") (internal quotations and cite omitted).

invention is", it is "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *White v. Dunbar,* 119 U.S. 47 at 52.

Likewise, evidentiary findings regarding the contrasts between the claims are also necessary. When there are multiple claims of varying scope, each of the claims must be construed in light of the other claims of the patent. An obviously intended contrast in the words of different claims points to a difference in purpose and meaning.[2] *See also,* 37 C.F.R. § 1.75(b)[3].

A further principle is the primary importance of the specification in claim construction. Since a patent is an integrated instrument, the evidence of the accompanying written description or specification of the patent *must* be used to construe the claims.[4]

Additionally, this Court has also set forth the parameters of the doctrine of prosecution history estoppel. Estoppel

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2. *Smith v. Snow,* 294 U.S. 1, 13-14 (1935) ("The omission of these requirements from Claim 1 is the more pointed as the other claims of the patent speak in particular [of these additional elements]. Thus, by striking and obviously intended contrast with other claims, Claim 1 covers broadly the essential elements of the Smith invention as we have already described it"). This has also come to be known as the doctrine of claim differentiation, and embodies the common sense notion that the language of different claims should not be interpreted to make them identical in scope.

3. "More than one claim may be presented provided they differ substantially from each other".

4. "The claims of a patent are always to be read or interpreted in light of its specifications" *Schriber-Schroth Co. v. Cleveland Trust Co. et al.,* 311 U.S. 211, 217 (1940); *See also, Seymour v. Osborne,* 78 U.S. 516, 547 (1871) ("Where the claim . . . contains words referring back to the specifications, it cannot properly be construed in any other way").

arises when an amendment is made during prosecution to secure a patent, and the amendment narrows the patent's scope.[5]

With respect to the hierarchy between these principles, this Court's precedent provides that the words of the claims are paramount. *See e.g.*, fn. 1 *supra.*

3. Furthermore, since patents are technical documents written within the context of a field of engineering or science, this Court has long recognized that the inquiries in question require an assessment of evidence in light of the understanding of those skilled in that field. *See, United Carbon Co. v. Binned & Smith Co.*, 317 U.S. 228, 233 (1942) ("Here as in many other cases, it is difficult for persons not skilled in the art to measure the inclusions or appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself.").[6] The same holds true in terms of assessing patent validity.[7]

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5. *See e.g., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002).

6. *Markman*, 517 U.S. at 385-386

> ("The specifications . . . profess to describe mechanisms . . . and other manufactured products, which have their existence *in pais*, outside of the documents themselves; and which are commonly described by terms of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright . . . . Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself . . . . This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*.")

(internal citation omitted); *General Electric Co. v. Wabash Appliance*

(Cont'd)

Thus, it is long established in this Court that to assess claim construction and patent validity, it is necessary to assess the understanding of those skilled in the art with respect to the plain meaning, the teachings of the specification, the contrasts between the claims, the distinctions between the claims as modified during prosecution and in the context of the prior art, and the effect of prior art itself. The questions of who is skilled in the art; the state of the art at the time of the invention; the meaning of specialized terms to that person; the problem a patent was solving; and whether a construction was disallowed during prosecution, are all relevant to construction.[8] This necessarily requires evidentiary findings at the trial court level.

At the same time, however, much of those findings have increasingly become superfluous, since the Federal Circuit affords them no evidentiary weight.[9] In the present case, however, the Court of Appeals went yet a step further, by upholding claim construction findings that were not even based on any real or articulated findings. With respect to the '620 patent, for example, none of the required evidentiary underpinnings were analyzed – at all – on the trial level with respect to construction of key claim terms such as the invert

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(Cont'd)
Corp., 304 U.S. 364, 372 (1938) ("we may doubt whether the language used in Claim 25, taken by itself, conveyed definite meaning to those skilled in the art of incandescent lighting").

7. *Seymour*, 78 U.S. at 555 (invalidity based on a prior reference requires an assessment in light of the understanding of one skilled in the art or science to which it appertains).

8. *See e.g., Phillips*, 415 F.3d at 1332 (Mayer, C.J., dissenting)

9. *Phillips*, 415 F.3d at 1330 (Mayer, C.J., dissenting); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039 (2006) (Michel, C.J., dissenting).

limitation, which affected important issues of patent validity. Yet, the Court of Appeals nonetheless entered judgment without any such evidence of record.

Likewise, with respect to the '931 patent, evidence of the claim language, claim differentiation, the specification, and the plain meaning were all disregarded, and not even addressed in the Court of Appeal's decision – despite the primary importance of those factors under this Court's precedent. Instead, a new reading of prosecution disclaimer was adopted that is itself inconsistent with the long standing precedent of this Court.

The Technology

The patents in this case relate to no-spill drinking cups, which are used in the transition period when babies are moving from bottle feeding to normal drinking cups. At that time, young children often knock their cups over or shake them upside down, causing liquid to spill all over their environment. As a result, an industry has developed within the past several decades in these devices, which have liquid valves in them to prevent liquid spillage. Most parents prefer transitioning their children using these cups.

The engineering problems associated with designing these products encounter two opposite and competing requirements. On the one hand, the valves need to be designed to provide a tight seal to prevent liquid flow when force is applied upon turning the cup over or vigorously shaking it upside down. On the other hand, the valves need to be designed to provide a sufficiently weak seal so that liquid will flow out easily when a baby of limited strength attempts to drink.

Reconciling these two requirements can be difficult and has occasioned numerous patents in this field. The patents-

in-suit, U.S. Patent No. 6,321,931 ("the '931 patent") and U.S. Patent No. 6,357,620 ("the '620 patent") both claim inventions of Nouri E. Hakim ("Hakim") that have presented several elegant solutions to these problems.

The Patents

The two patents include a set of initial designs, and improved variations thereon. The broadest claims of the '931 patent, for example, were directed to a no-spill valve with a flexible membrane having an opening therein. In a closed position of the valve, the opening of the membrane rests against a fluid-impermeable blocking element, thereby sealing against fluid flow. (App. 58a, 70a). When the baby attempts to drink, negative pressure or a partial vacuum is applied against the membrane, causing the opening to rise away from the blocking element, and providing a path through the opening for liquid to emerge from the cup. (App. 58a, 70a).

In further improvements on the design, the membrane undergoes an unusual change of configuration during use. Namely, the membrane inverts (App. 62a, claim 10) or begins to invert (App. 54a, claim 12). In a further preferred embodiment, an anti-inversion member is placed above the membrane (App. 56a, claim 21).

The District Court Proceedings

After commercialization of Hakim's cups by his company, Luv n' care, Ltd., and positive market reception, Respondents began selling no-spill cups copying features of the patented valves that Hakim had introduced first into the market. Further thereto, Hakim filed suit for patent infringement in the U.S. District Court for the Western District of Louisiana.

In the district court, Hakim asserted a number of different patent claims against Avent, each of which had different limitations therein. He asked that the court hold a Markman hearing to construe the meaning of the claims, on a claim-by-claim, element-by-element basis, to address the evidentiary issues regarding the limitations in each claim to those of skill in the art, and their meaning in the context of the specification and other claims.

In response, the district court refused to hold a Markman hearing or to take any testimony. Rather, it entered patent claim construction and validity rulings without relying on any evidence from those of skill in the art, or addressing numerous of the evidentiary bases mandated by this Court.

For example, various claims included a limitation that the membrane inverts (App. 62a, claim 10) or begins to invert (App. 54a, claim 12) during use. Hakim demonstrated that the term "invert" requires a reversal in position, as per the specifications of both the '931 and '620 patents, and the understanding of one of skill. In other words, as shown in the figures (App. at 70a), the red surface of the membrane moves from being the inside surface of a bowl (see top left) to being the outside surface of a bowl (see bottom left)[10]. Put in another way, the red surface goes from concave to convex.

The district court, however, engaged in no analysis of what the term "invert" would mean to a skilled engineer in this art, or in any other definition. The court reduced the many claims of the '620 patent in dispute to just a single sentence,[11]

10. Color has been added to the figures in the appendix (which are taken from the patents-in-suit), for purposes of illustration and clarity.

11. "[B]oth of these extremely simple devices are made so that, when a child sucks on the spout, the flexible member flexes up the post, breaking the seal, and allowing the flow of liquid." (App. 30a).

ignoring the particular terms used in each of those very different claims.

In fact, Hakim was told that the specific claim limitations are not important. In surprising fashion, the court rejected Hakim's basic request that it engage in construction of the term 'invert', deriding Hakim's insistence on a precise claim construction as "semantical gymnastics". (App. 30a).

Instead of construing the disputed limitations, the court stated that the particular claim terms "matter not". (App. 30a) It expressly refused to draw any distinction between the meaning of the term "invert" and very different terms such as "flex", "slide", "move", "lift", "or any other term denoting movement" (App. 30a).

Yet each of those descriptions of the membrane's dynamics have very different implications to those skilled in designing products in this field. They represent different structural and functional descriptions of the membrane's response to the forces applied during use, which have significant practical ramifications from the perspective of the engineers designing these valves.

There was no indication that the district court made any effort to understand these distinctions, that it actually construed the term invert, or that engaged in any of the predicates required by this Court to do so. None of the evidentiary underpinnings required by this Court were ever cited or given weight. It conducted no analysis of the specification with respect to the invert term, gave no weight to the differences between the claims (some of which required inversion and some of which didn't), and cited no prosecution history.

In short, no evidentiary findings whatsoever were conducted by the district court as to the invert limitation for claim construction purposes. Similarly, no evidence was cited

by the district court pointing to any prior art having the specific invert limitation therein. Although the defendants had cited a foreign patent reference against the patent, the court identified no evidence that the inversion feature was actually in that reference. Nonetheless, the district court invalidated the inversion claims of the patent anyway, contrary to this Court's precedent.[12]

The issue in the '931 patent was likewise one of claim construction; namely, whether claims to an "opening" include a hole. The district court ruled that the hole in defendant's products is not an opening. The court effectively limited the term opening to the properties of a slit, based on prosecution remarks in a parent application that discussed the benefits of using a slit in the membrane. In fact, however, that parent application was abandoned; in the continuation which actually issued as the '931 patent, an amendment was entered to remove "slit" from all of the independent claims to broaden it to the issued "opening" language.

The Federal Circuit Decision

On appeal, the Federal Circuit affirmed. With respect to the "invert" limitation, the Court of Appeals identified no evidence in the record as to what one of skilled in the art would specifically understand regarding this unusual change in membrane configuration. No analysis was conducted of the specification and its figures with respect to the term. Nor was any discussion, weight or consideration given to the evidence to be understood from the differences between the claims in suit. Although these are all evidentiary

12. *Seymour*, 78 U.S. at 555 (invalidity based on a prior reference requires an assessment in light of the understanding of one skilled in the art or science to which it appertains).

predicates under this Court's precedent, none of them were addressed.[13]

Rather, the Court criticized Hakim's methodological position. (App. 11a).[14] That rejection of his request for reasoned explicit evidentiary findings goes to the heart of the fundamental problems with current claim construction. This Court has set forth a specific evidentiary foundation which must be surveyed for any principled construction to be conducted.

With respect to the '931 patent, the Court of Appeals upheld the district court's decision that Hakim emphasized the "slit" during prosecution of a parent application to distinguish the claims from the cited references. However, at the time Hakim made those statements during prosecution, "slit" was expressly recited in several independent claims. Hakim later abandoned those claims and in the continuation application which actually issued as the '931 patent, he deleted the term "slit" from all independent claims having it and replaced it with "opening". (App. 59a-61a, claims 1, 3,

13. Likewise, any question of who qualifies as one of ordinary skill in the art; the meaning and scope of the patent terms to that person; the state of the art at the time of the invention; and the problem the patent was solving; were all disregarded.

14. It asserted that Hakim did not state what meanings for the terms would affect validity or assert that the district court's analysis was incorrect, though Hakim, in fact, did so expressly and repeatedly throughout his appeal briefs. *See, Appellant's Brief* at 48-50; *Reply Brief* at 28-29. For example, for the claims relating to inversion, Mr. Hakim stated that inversion requires a reversal in position, such that an outside surface becomes an inside surface and an inside surface becomes an outside surface (e.g. concave becomes convex or vice versa). *Appellant's Brief* at 49-50; *Reply Brief* at 28. He also showed that the cited prior art does not teach or suggest this, and demonstrated that the outside and inside of the IT '286 membrane was not even capable of inversion. *Appellant's Brief* at 49; *Reply Brief* at 26-28.

and 5). He specifically moved the term slit into various dependent claims only. (App. 64 a, claims 27, 28 and 29).

In the prosecution history, he likewise stated that he was deleting the term slit, to broaden the scope of the independent claims to an opening. Furthermore, the specification expressly defined the term opening as including a hole. (App. 59a).

The Court of Appeals, however, held the term "opening" to the meaning of the prior slit limitation, despite the fact that "slit" had been removed by amendment, since Hakim hadn't 'rescinded' his prior remarks during prosecution. It gave no weight to the fact that the continuation application which actually gave rise to the '931 patent was amended to delete the term slit from the independent claims for the express purpose of broadening it. It also gave no weight to the specification definition, which must be adhered to under this Court's precedent, and which expressly defined an opening as including a hole. (App. 59a). It likewise gave no weight to the various dependent claims that specifically claimed a slit, requiring a reading under this Court's precedent that the opening language in the independent claims is not limited to a slit. It also gave no weight to the evidence that one of skill in this field would certainly recognize that the plain meaning of "opening" includes a hole.[15]

In fact, the specification definition, claim differentiation, and plain meaning to those skilled in the art – all necessary evidentiary predicates under this Court's precedent – were not even addressed in the court's decision.

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15. *See also, Display Techs. v. Paul Flum Ideas, Inc.*, 282 F.3d 1340, 1345 (Fed. Cir. 2002) ("The ordinary definition of the term 'aperture' is 'an opening; hole; gap.'")

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S NEWEST RULE OF PROSECUTION DISCLAIMER IS CONTRARY TO THIS COURT'S PRECEDENT

1. The Court of Appeals' new rule of prosecution history disclaimer, which allows claim limitations to be read back into the claims after they are removed, is fundamentally inconsistent with this Court's long standing precedent. Elimination of a term from a claim signals a change in scope, such that the eliminated term and its properties cannot be read back into the claim. "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." *Schriber-Schroth Co.*, 311 U.S. at 220-221. It is an established principle that "an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed." *Id.* at 218. The fact that the earlier claim was narrower and then broadened does not change this. "True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower." *Id.* at 221.

2. Furthermore, with respect to the legal hierarchy between different sources of evidence, this Court's precedent provides that it is the words of the claims themselves which are paramount. *Merrill v. Yeomans*, 94 U.S. 568, 570, 24 L.Ed. 235 (1876) (the claims are "of primary importance, in the effort to ascertain precisely what it is that is patented."); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339, 81 S.Ct. 599, 5 L. Ed.2d 592 (1961) ("the claims made in the patent are the sole measure of the grant");

See also, White v. Dunbar, 119 U.S. 47, 52, 7 S.Ct. 72, 30 L.Ed. 303 (1886) (Because the patentee is required to "define precisely what his invention is," the Court explained, it is "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."); *Cont'l Paper Bag Co. v. E. Paper Bag Co.,* 210 U.S. 405, 419, 28 S.Ct. 748, 52 L.Ed. 1122 (1908) ("the claims measure the invention"); *McCarty v. Lehigh Valley R.R. Co.,* 160 U.S. 110, 116, 16 S.Ct. 240, 40 L.Ed. 358 (1895) ("if we once begin to include elements not mentioned in the claim, in order to limit such claim . . . we should never know where to stop"). It is not the role of prosecution history to change the plain terms of the claims. *Goodyear Dental Vulcanite Co. v. Davis,* 102 U.S. 222, 227 (1880).

3. It is further significant that the slit limitation previously argued was explicitly moved out of the independent claims and into dependent claims. Under this Court's claim construction principles, limitations in the dependent claims may not be imputed to independent claims which do not recite them. *Smith v. Snow, et al.*, 294 U.S. 1, 13-14, 55 S.C. 279, 284 (1935).[16] That principle was also not addressed in the court's decision.[17]

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16. ("The omission of these requirements from Claim 1 is the more pointed as the other claims of the patent speak in particular [of these additional elements]. Thus, by striking and obviously intended contrast with other claims, Claim 1 covers broadly the essential elements of the Smith invention as we have already described it").

17. The doctrine of claim differentiation is embodies the common sense notion that the language of different claims should not be interpreted to make them identical in scope. Even under the Federal Circuit's own case law, the placement of the slit language in dependent claims results in a heavy presumption against the independent claims being limited to a slit. *See also, Phillips v. AWH Corp.*, 415 F.3d 1303, (Cont'd)

4. When claim scope is changed during prosecution, this Court has instructed that the specification is to be consulted to determine the proper meaning of disputed claim terms: "the amended and cancelled claims are to be read in the light of the specifications." *See, Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 311 U.S. 211, 222, 61 S.C. 240 (1940). Yet, the specification expressly defined the term opening as covering any form of opening, including a hole. (App. 59a). The specification definition was also not addressed by the Federal Circuit.

The court's failure to give weight to the specification elevates old remarks in a parent application above the express definition in the specification and the terms of the claims as finally issued. This is analogous to making legislative history about initial language in a draft statute – initial language never enacted but instead amended – more important than the definition in the statute and the broader, plain terms of the statute as actually and finally enacted. The role of prosecution history is to understand the meaning of the claims

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(Cont'd)

1315 (Fed. Cir. 2005) (en banc) ("[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim."); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004); *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987). The Court of Appeals' own presumption was not addressed anywhere in its decision. Under claim differentiation, when broad independent claims reciting a general term are followed by dependent claims reciting a specific example of that term, the independent claims are not limited to the specific example, but must be interpreted generally. Thus, for example, an independent claim claiming the use of wood, followed by a dependent claim reciting that the wood is mahogany, demonstrates that the independent claims are not limited to mahogany, but rather encompass any type of wood.

– not to change the plain terms of them. *Goodyear,* 102 U.S. at 227 (although the prosecution history should be used to understand the language used in the patent, it cannot "enlarge, diminish, or vary" the limitations in the claims.").

5. The error in the Federal Circuit's approach is particularly significant since the specification definition is what the Patent Office relies on during the application process. As set forth in the Code of Federal Regulations, the meaning of the claim language when the applicant is applying for a patent is determined by reference to the specification.[18] The internal guidelines followed by Examiners in the Patent Office provide likewise. *See, Manual of Patent Examining Procedure* § 2111 (during examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification); *see also, In re Hyatt,* 211 F.3d 1367, 1372 (Fed. Cir. 2000). Clearly, the broadest interpretation of an opening (or any interpretation for that matter) includes a hole.

By assuming that the Examiner did not give a claim term ("opening") the scope set forth in the specification at the time of the amendment, the decision conflicts with the very principles followed by the Patent Office during prosecution of the claims. As such, it works fundamental unfairness by applying a different set of principles after issuance of the patent than were applied during examination at the Patent Office.

6. This is further exacerbated by the fact that the applicant's actions were fully consistent with the Court of Appeals' own precedent which was in effect at the time of

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18. *See,* 37 C.F.R. §1.75(d)(1) ("The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description").

amendment. That precedent provided that a limitation (here, the "slit") may not be read back into the claims after it is expressly removed during prosecution.[19] It also held that for prosecution disclaimer to be found, it must be clear and unambiguous such that there is an unmistakable surrender of the claim scope in question during prosecution. *See, 3M,* 350 F.3d at 1373. An applicant's removal of a limitation to broaden the claim is totally inconsistent with the notion that the applicant unmistakably wished to be limited to that pre-amendment, limitation or to remarks regarding it.

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19. In *Telectronics,* for example, the patentee argued that the use of a skin electrode – expressly recited in the pending claims – was a distinguishing feature of the invention. *United States v. Telectronics, Inc.,* 857 F.2d 778, 782 (Fed. Cir. 1988). The claims were later amended to remove the skin electrode limitation. *Id.* at 783. This Court ruled that "arguments emphasizing the use of a skin electrode, which were made at the time the application claims explicitly contained such a limitation, cannot furnish a basis for restricting [an issued claim], which lacks any such limitation." *Id. See also, 3M Innovative Properties Co. v. Avery Dennison Corp.,* 350 F.3d 1365, 1372 (Fed. Cir. 2003) ("A broadening amendment made during the prosecution history . . . supports a plain-meaning construction . . . without a sequential-embossment limitation . . . . The fact that 3M broadened its claims . . . and dropped the sequential limitation is perhaps unusual, but it is entirely permissible, and the plain language of the claim as issued must control."); *Kistler Instrumente AG v. United States,* 628 F.2d 1303, 1308 (Ct. Cl. 1980)

> ("It is significant that none of the claims in the patent which ultimately issued contain the narrow limitation of original claim 2 . . . . *It must be concluded that the Patent Office did not feel that this was a critical limitation. Thus, defendant's insistence upon this court's reading back into the claims limitations which were originally there and were removed during prosecution of the application through the Patent Office cannot be permitted.*"

(Emphasis added).

7. Furthermore, by flagging his amendment to the Examiner and letting him know that he was broadening the claims, an applicant does what is entirely reasonable, and should logically expect that the claims are being broadened under then-existing law. The placement of the limitation in question into dependent claims yet further signals to the examiner that only the dependent claims were being limited to a slit and not the independent ones. 37 C.F.R. § 1.75(b). Consistent with established Patent Office practice, the Examiner necessarily considered the definition set forth in the specification and the broadest reasonable meaning of the claims, and must have treated the word opening as being broader than a slit, and including a hole.

The Court of Appeals' decision necessarily assumes that the Examiner did not examine the claims, which is without any reasonable basis, and which is contrary to this Court's precedent as well. *United States v. Chemical Foundation,* 272 U.S. 1, 14-15 (1926) ("The presumption of regularity supports the official acts of public officers, and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties")[20].

Applicants removing limitations from their claims had every reason to expect that their actions were sufficient to broaden the claims, and there is every reason to expect that Patent Examiners believed likewise, based on the Code of Federal Regulations and the Patent Office's own internal procedures. But under this new precedent, thousands of patentees will be penalized for following practices consistent

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20. *See also, Intervet America, Inc. v. Kee-Vet Labs., Inc.,* 887 F.2d 1050, 1054 (Fed. Cir. 1989)

> ("The presumption of validity under 35 U.S.C. § 282 carries with it a presumption the examiner did his duty and knew what claims he was allowing . . . the claims as allowed are what we have to deal with and it is not for the courts to say that they contain limitations which are not in them.").

with this Court's precedent, and the Court of Appeals' own *Telectronics* precedent in effect at the time they prosecuted their applications. Amendment of claims to broaden them is extremely common during patent prosecution – under this new rule, the patent protection that should have resulted is eviscerated, allowing copyists to improperly gain free access to the benefits of inventions requiring extensive research and investment that they did not contribute to.

7. Under the Court of Appeals' decision, there is a new presumption that no difference is recognized or considered by Patent Examiners at the time of amendment unless an additional "rescinder" is entered by the applicant.[21] That presumption is also contrary to precedent. When a claim is amended from one term to another, it must be deemed that "By the amendment [the patentee] recognized and emphasized the difference between the two phrases." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002). By its very nature, removal of a term from a claim removes any basis for restricting claims based on earlier remarks about that term. This new presumption also gives no weight to the applicant's express statement to the Examiner that he is broadening the claims.

8. Thus, the CAFC's holding creates a new rule requiring patentees that have broadened their claims through amendment to take the additional – and previously unprecedented – step of expressly rescinding the prior scope

21. In fact, while the court held that the Examiner allowed the continuation claims without further prosecution (App. 8a), that was inaccurate. Applicant submitted an IDS in the continuation which brought further references to the Examiner's attention, and argued that the slit term is broader than opening. Since he had to examine those references vis-a-vis the claims, he could not have failed to notice that the language was broader, and not limited to a slit. His allowance of the claims demonstrates that the properties of a "slit" were not regarded as necessary for patentability.

of the claim. This new rule will affect thousands of issued patents where the practitioner and the Examiner understood exactly what was taking place, but cannot point to an express statement of rescission.

The decision effectively requires a further "disclaimer of any prior disclaimer" to repudiate a limitation, beyond its explicit deletion from the claims. It significantly, and unfairly, reduces the value of large numbers of unexpired patents with broadened claims, in many cases entirely eliminating the benefits of the broadening. *See Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 32 (1997) ("To change so substantially the rules of the game now could very well subvert the various balances the PTO sought to strike when issuing the numerous patents which have not yet expired and which would be affected by our decision.").

By this new rule – which applies with no prior notice to those whose patents have already issued – the Federal Circuit is effectively restaking the position that a surrender of subject matter during prosecution precludes recapturing that subject matter, even if equivalent to the subject matter expressly claimed. That position was already explicitly rejected by this Court. *Id.* at 30-31.

II. ARTICLE I OF THE CONSTITUTION AND THIS COURT'S MARKMAN DECISION REQUIRE A CONSISTENT EVIDENTIARY METHODOLOGY FOR CLAIM CONSTRUCTION DETERMINATIONS

Perhaps the greatest problem facing the patent field today is the unpredictability of the Federal Circuit's approach to any given question of claim construction. The most recent study, for example, has found that more than one in every

two claim constructions rulings is reversed on appeal.[22] Other earlier studies have come to similar results.[23] In other words, one has no more than a coin toss's chance of divining the ultimate claim construction conclusion of a Federal Circuit panel.[24] *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting) (this reversal rate, hovering near 50%, is the worst possible). Furthermore, a CAFC panel can even adopt a claim construction contrary to the one it has itself previously adopted.[25]

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22. Michael Saunders, Note, A Survey of Post-Phillips Claim Construction Cases, 22 Berkeley Tech. L.J. 215 (2007) (the overall reversal rate in claim construction cases, excluding summary affirmances, is 53.5%, and the percent of cases where at least one construction changed is 39.5%).

23. *See e.g.*, Christian A. Chu, Empirical Analysis of the Federal Circuit's Claim Construction Trends, 16 Berkeley Tech. L.J. 1075, 1092 (2001) (finding an overall reversal rate of 47.3% excluding Rule 36 affirmances and 36.6% including such affirmances); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting) ("Nonetheless, one study shows that the plenary standard of review has produced reversal, in whole or in part, of almost 40% of all claim constructions since Markman I.")

24. *See also, Phillips*, 415 F.3d at 1330 ("What we have wrought . . . is the substitution of a black box, as it so pejoratively has been said of the jury, with the black hole of this court. Out of this void we emit "legal" pronouncements by way of "interpretive necromancy"; these rulings resemble reality, if at all, only by chance.").

25. *Cybor*, 138 F.3d at 1476-1477 (Randall, J., dissenting)

> ("One other case makes the point even more persuasively. In *CVI/Beta Ventures, Inc. v. Tura LP* . . . the Federal Circuit reversed its own earlier claim interpretation as a question of law when the defendant and stage of the proceedings changed . . . . Although this court referred to the New York district court's "error," the Federal Circuit had in fact reversed itself.").

Such uncertainty is completely contrary to the express requirements of this Court. This Court has unequivocally rejected the prospect of a "zone of uncertainty" as to the scope of patent claims, and has done so repeatedly since the enactment of the Patent Act of 1836. *Markman,* 517 U.S. at 390; *United Carbon,* 317 U.S. at 236. Nothing can be more just and fair, both to the patentee and to the public, than that they should be able to reliably assess the correct scope of the claims of a patent. *Merrill,* 94 U.S. at 573.

The protection of rights in new inventions was sufficiently important to the founders that it was expressly enshrined in Article I, Section VIII.[26] The Constitution mandates that inventors must be secured the exclusive rights to their discoveries to promote the progress of science and the useful arts. The requirement for *secure* rights necessarily requires a predictable and consistent claim construction regime, for the benefit of inventors no less than the public.

As this Court stated over a hundred years ago,

> "[t]he growth of the patent system . . . has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded . . . The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights".

Merrill, 94 U.S. at 573.

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26. . . . . "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

Likewise, as reaffirmed in *Markman*, "the limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *Markman,* 517 U.S. at 390, *citing General Electric,* 304 U.S. at 369. A claim construction regime with the current level of unpredictability fails to meet the requirements of this Court and the Constitution.

Even the judges of the Federal Circuit have candidly recognized the importance of predictability in the field.[27] But despite that court's recognition of the problem, and no doubt

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27. *See e.g.,* Hon. Paul R. Michel, A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Introduction: the Challenge Ahead: Increasing Predictability in Federal Circuit Jurisprudence for the New Century, 43 Am. U. L. Rev. 1231, 1233 (1994)

> ("I believe the court has failed in one respect. While greatly improving doctrinal clarity and national consistency, we have done little to increase predictability . . . By "predictability," I mean that the actual outcome of potential litigation may be accurately forecast through the consistent application of clearly stated legal principles to new factual situations");

Hon. Pauline Newman, Introduction: the Federal Circuit: Judicial Stability or Judicial Activism? 42 Am. U. L. Rev. 683, 688 (1993) ("Indeed, unless there can be reasonable reliance on legal advice given during the stages of invention and innovation, unless that advice can correctly predict the legal principles to be applied by the court, the court is not fulfilling its obligations to the public"); Hon. Randall R. Rader, The United States Court of Appeals for the Federal Circuit: the Promise and Perils of a Court of Limited Jurisdiction, 5 Marq. Intell. Prop. L. Rev. 1, 11 (2001) ("You need to have a clear standard that you can conform your conduct to. When the lawyers can say, "I have four cases here, four cases there, take your pick." That is not a happy situation for a CEO or a Dot Com start-up company or any one else.")

its best intentions, it is abundantly clear that predictability has been long absent.

The continuing unpredictability in the claim construction enterprise is amply demonstrated by this case. With respect to the '931 patent, the court adopted a new rule of disclaimer that changes the scope and value of thousands of patents previously issued under prior precedent. It did so without even addressing the contrary weight of this Court's primary principles of claim interpretation. With respect to the '620 patent, the court upheld claim construction rulings regarding claim terminology ("invert"), when absolutely none of the evidentiary underpinnings required by this Court's precedent were addressed at the district or appellate level.

Although Markman addressed the role of the judge in claim construction, it has been numerous decades since any substantive rulings have been issued by this Court regarding the evidentiary factors that must be addressed during claim construction and the means for choosing between competing principles in claim construction when they arise. Thus, the Federal Circuit rarely directly relies on this Court's precedent for claim construction issues regarding literal infringement. For example, of the 24 claim construction decisions issued this year from January 1-July 23, 2007 (other than the present case), none appear to have directly relied on any decisions of this Court to guide questions of claim construction. Indeed, only one of those 24 appears to even have cited any decisions of this Court to guide such questions, and that reference was in a dissenting opinion by a new member of the court of appeals. *See, Acumed LLC v. Stryker,* 483 F.3d 800, 814 (Fed. Cir. 2007) (Moore, J., dissenting).

This underscores the importance of an explicit methodology of claim construction from this Court, confirming the factual and legal roles to be given to the

various evidentiary predicates,[28] and the means for choosing between legal principles when they conflict. "The necessity of a sensible and systematic approach to claim interpretation is axiomatic. The Alice-in-Wonderland view that something means whatever one chooses it to mean makes for enjoyable reading, but bad law."[29] Without definite and firm direction by this Court as to the specific methodology that must be regularly followed in claim construction, the current inconsistency and unpredictability will continue and likely only worsen.

CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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28. *See e.g., Phillips*, 415 F.3d at 1331 ("there can be no workable standards by which this court will interpret claims so long as we are blind to the factual component of the task.") (Mayer, C.J., dissenting).

29. *See e.g., Autogiro Co. of America v. United States*, 384 F.2d 391, 396-97 (Ct. Cl. 1967).